

### **REMARKS**

In response to the Office Action mailed July 18, 2007, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-6, 8-10 and 18-39 were previously pending in this application. Claims 1-6, 8-10, 18-21 and 27-39 are amended herein. No claims have been added or cancelled. As a result, claims 1-6, 8-10 and 18-39 remain pending for examination, with claims 1, 9, 10 and 18 being independent. No new matter has been added.

### **Objections to the Specification**

The Office Action objects to the Specification under 37 C.F.R. §1.75(d)(1) for purportedly failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action contends that the claim terms “computer-readable medium”, “first reproducing unit” and “second reproducing unit” lack support in the specification “or even in the drawings.”

The claims are amended herein to remove any reference to a “computer-readable medium” or “reproducing unit.” Specifically, claims 1 and 18 are amended to replace the term “reproducing unit” with “reproduction unit”, for which the specification provides extensive support (see, e.g., p.15, line 20-p.16, line 15). Claims 10 and 31-39 are amended to replace the term “computer-readable medium” with “program storage medium,” for which the specification also provides extensive support (see, e.g., p.46, line 22-p. 47, line 7).

In view of the foregoing, Applicant respectfully requests withdrawal of the objection to the specification under 37 C.F.R. §1.75(d)(1).

Objections to the Drawings

A. Objection Under 37 C.F.R. §1.84 (p)(4)

The Office Action objects to the drawings under 37 C.F.R. §1.84 (p)(4) for purportedly using the reference characters “11-1” and “11-2” to designate different features in FIGS. 1 and 12. Applicants respectfully traverse this objection.

The use of reference characters “11-1” and “11-2” is consistent in FIGS. 1 and 12. Specifically, Applicants’ specification states that the flowchart depicted in FIG. 12 is a process performed by the portable terminals 11-1 and 11-2 (p.28, lines 1-3). Portable terminals 11-1 and 11-2 are also shown in FIG. 1 (p.13, lines 3-6). Because reference characters 11-1 and 11-2 are used consistently in FIGS. 1 and 12, Applicants respectfully request that the objection to the drawings under 37 C.F.R. §1.84 be withdrawn.

B. Objection To Drawings Purportedly Missing Labels

The Office Action also contends that Figs. 1, 4, 9, 13, 18, 19 and 20 are missing labels for each of the boxes shown therein. Applicants respectfully traverse this objection as well.

The Office Action cites no authority in support of its contention that each box in each of these figures must be accompanied by a label, and Applicants believe no such requirement exists. If the objection is to be maintained, Applicants respectfully request that the Examiner cite specific authority requiring Applicants to label each box in all of the figures.

C. Objection Under 37 C.F.R. §1.83(a)

The Office Action also objects to the drawings under 37 C.F.R. §1.83(a) for purportedly failing to depict each limitation recited by claims 1, 9, 10 and 18. Applicants respectfully traverse this objection.

Each feature specified in independent claims 1, 9, 10 and 18 is shown in the drawings. For example, the portable terminal of claim 1 comprises a reproduction unit configured to reproduce a

plurality of content data items (e.g., reproduction unit 77, FIG. 3), a control unit (e.g., control unit 71, FIG. 3) configured to detect a reproduction status of each content data item (represented, e.g., by the “reproduction time” column in the tables shown in FIGS. 5-7) when said each content data item is reproduced, and to select a recommendation content data item from said plurality of content data items (e.g., step S6, FIG. 8) depending on a reproduction status of said recommendation content data item, and a communication unit (e.g., communication unit 76, FIG. 3) configured to transmit to another portable terminal a list which shows said selected recommendation content data item (e.g., the list depicted in FIG. 7).

The method of claim 9 comprises steps of reproducing a plurality of content data items (shown, e.g., as steps S2, S7 and S8 in FIG. 8), detecting a reproduction status (shown, e.g., as steps S3 and S4 in FIG. 8), selecting a content data item (shown, e.g., as step S6 in FIG. 8), and transmitting a list (shown, e.g., as step S47 in FIG. 12). Claim 10 recites an article of manufacture comprising at least one program storage medium having instructions encoded thereon which, when executed, perform a method substantially similar to the method of claim 9, such that the features of claim 10 are also shown in the drawings. Claim 18 recites a data processing system having first and second data processing apparatus (shown, e.g., as 11-1 and 11-2 in FIG. 9), each of which comprises a reproduction unit (e.g., reproduction unit 77, shown in FIG. 3), a control unit (e.g., control unit 71, FIG. 3) and a communication unit (e.g., communication unit 76, shown in FIG. 3). As a result, the drawings show each feature of the invention specified in independent claims 9, 10 and 18.

In view of the foregoing, Applicants respectfully request that the objections to the drawings be withdrawn.

#### Claim Rejections Under 35 U.S.C. §101

Claims 10 and 31-39 are rejected under 35 U.S.C. §101 for purportedly reciting non-statutory subject matter. Specifically, the Office Action contends that because the specification does not specifically state that the computer-readable medium recited by these claims may not be embodied as a carrying signal, the scope of these claims includes a signal, which the Office Action

contends is non-statutory subject matter.

Without acceding to the propriety of this rejection, claims 10 and 31-39 are amended herein to recite an article of manufacture comprising at least one program storage medium. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 10 and 31-39 under 35 U.S.C. §101.

Claim 35 U.S.C. §103

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §103(a) as purportedly being obvious over U.S. Patent Publication No. 2002/0035692 to Moriai ("Moriai") in view of U.S. Patent Publication No. 2003/0191753 to Hoch ("Hoch"). As amended herein, each of claims 1-6, 8-10 and 18-39 patentably distinguish over the asserted combination.

A. Brief Overview of Cited References

1. Moriai

Moriai discloses a cellular phone having a clamshell design which is capable of downloading and reproducing content distributed from a distribution server (Abstract). In particular, the cellular phone is equipped with a controller which, if the phone is closed while it is downloading or reproducing content data, causes power to be supplied to the phone so that the download or reproduction process can be carried out to completion (Abstract).

The phone is equipped with a detection unit which detects whether the phone's casing is open or closed (§[0059]). If the casing is open, the phone is conferred a status which allows the download or reproduction of content data to begin (§[0175]). If the casing is then closed, the phone is conferred a status which allows it to continue the download or reproduction process until all of the content data is processed (§[0180]-[0185]).

2. Hoch

Hoch discloses a technique for filtering search results using a learning mechanism

(Abstract). When a request to search for content is received in a networked community, the search is performed, and the results are filtered based on information defining the persona of the user who executes the search (Abstract). Persona information may, for example, reflect the personal interests, behaviors and habits of the user (§[0040]). For example, persona information may include attributes of a user such as a favorite song list, artist list, comments on songs, etc. (§[0040]). Hoch discloses that persona information is automatically collected as the user employs a device by, for example, recording websites the user visits, music the user listens to, films the user watches, etc. (§[0041]).

B. The Cited Passages Of Hoch Are Not Prior Art To The Present Application

Hoch was filed March 25, 2003, and claims priority to a provisional application filed April 8, 2002. The present application was filed on July 22, 2003, and claims priority to a Japanese application filed July 22, 2002. Thus, Hoch is prior art to the present application only to the extent that disclosure of Hoch finds support in the provisional application.

The Office Action cites Fig. 3D and §§[0063], [0023], [0026], and [0073] of Hoch as purportedly meeting the limitation recited by each independent claim directed to a recommendation content data item. The provisional application includes neither the cited passages nor the cited figure. Instead, the provisional application provides a very high level, three-paragraph description of a proposed technique for improving search results in a “networked community space.” Because the provisional application fails to provide support for the cited passages and figure, the passages and figure are not prior art to the present application.

For at least this reason, the rejection of claims 1-6, 8-10 and 18-39 under 35 U.S.C. §103(a) as purportedly being obvious over Moriai in view of Hoch is improper and should be withdrawn.

C. Claims 1-6 and 8

As amended herein, claim 1 recites a portable terminal comprising: a reproduction unit configured to reproduce a plurality of content data items; a control unit configured to detect a reproduction status of each content data item when said each content data item is reproduced by said

reproduction unit, and to select a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item; and a communication unit configured to transmit to another portable terminal a list which shows said selected recommendation content data item.

Without acceding to the propriety of the asserted combination, Applicant respectfully points out that the cited references fail to satisfy all of the limitations recited by amended claim 1. For example, neither of the cited references recites a portable terminal comprising a reproduction unit, control unit and communication unit meeting the limitations of amended claim 1.

Previously pending claim 1 recited a “data processing apparatus” comprising a reproduction unit, control unit and communication unit. The Office Action contends that Moriai satisfies this limitation through the disclosure of an overall communication system which includes a cellular phone and distribution server. That is, the Office Action contends that the cellular phone of Moriai satisfies the limitations directed to a reproduction unit and a control unit, and that the distribution server satisfies the limitation directed to a communication unit. Although Applicant respectfully traverses this interpretation of Moriai, claim 1 is amended herein to recite a portable terminal rather than a data processing apparatus. Moriai fails to disclose or suggest a portable terminal that comprises a reproduction unit, control unit and communication unit, and certainly not one which satisfies the remaining limitations of amended claim 1. For example, Moriai says nothing at all relating to a portable terminal having a communication unit configured to transmit, to another portable terminal, a list showing a selected recommendation content data item.

Hoch fails to remedy this deficiency of Moriai, as Hoch says nothing at all relating to a portable terminal, and certainly not one comprising a reproduction unit, control unit and communication unit.

In view of the foregoing, amended claim 1 patentably distinguishes over the asserted combination, such that the rejection of claim 1 under 35 U.S.C. §103(a) as purportedly being obvious over Moriai in view of Hoch should be withdrawn.

Claims 2-6 and 8 depend from claim 1 and are allowable for at least the same reasons.

C. Claims 9 and 22-30

As amended, claim 9 recites a data processing method for use with a portable terminal, the method comprising steps of: reproducing a plurality of content data items; detecting a reproduction status of each content data item when said each content data item is being reproduced; selecting a recommendation content data item being reproduced from said plurality of content data items depending on a detected reproduction status of said recommended content data item; and transmitting a list which shows said selected recommended content data item to a second portable terminal.

It should be appreciated from the discussion above relating to claim 1 that the asserted combination fails to disclose or suggest a data processing method which satisfies the limitations of claim 9. Accordingly, claim 9 patentably distinguishes over the asserted combination, such that the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 22-30 depend from claim 9 and are allowable for at least the same reasons.

D. Claims 10 and 31-39

As amended, claim 10 recites an article of manufacture comprising at least one program storage medium having instructions encoded thereon which, when executed by a portable terminal, perform steps of: reproducing a plurality of content data items; detecting a reproduction status of each content data item when said each content data item is being reproduced; selecting a recommendation content data item being reproduced from said plurality of content data items depending on a detected reproduction status of said recommendation content data item; and transmitting a list which shows said selected recommendation content data item to a second portable terminal.

It should be appreciated from the discussion above relating to claim 1 that the asserted combination fails to disclose or suggest an article of manufacture which satisfies the limitations of claim 10. Accordingly, claim 10 patentably distinguishes over the asserted combination, such that

the rejection of claim 10 under 35 U.S.C. §103(a) should be withdrawn.

Claims 31-39 depend from claim 10 and are allowable for at least the same reasons.

E. Claim 18

As amended herein, claim 18 recites a data processing system having a first portable terminal and a second portable terminal. The first portable terminal comprises a first reproduction unit configured to reproduce a plurality of content data items, a first control unit configured to detect a reproduction status of each content data item when said each content data item is being reproduced at said reproducing unit, and to select a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item; and a first communication unit configured to transmit to the second portable terminal a first list which shows said selected recommendation content data item.

It should be clear from the discussion above with reference to claim 1 that the asserted combination of Moriai and Hoch fails to disclose or suggest a data processing system which satisfies the limitations of amended claim 18. Accordingly, claim 18 patentably distinguishes over the asserted combination, such that the rejection of claim 18 under 35 U.S.C. §103(a) as purportedly being obvious over Moriai in view of Hoch should be withdrawn.



**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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